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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,737

01/16/2004

Kevin T. Burt

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/758,737	<b>Applicant(s)</b> BURT ET AL.	
	<b>Examiner</b> ALICIA CHEVALIER	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/10/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **RESPONSE TO AMENDMENT**

### ***Request for Continued Examination***

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on June 25, 2008 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 1-3, 5-16 and 18-22 are pending in the application, claims 4 and 17 have been cancelled.
3. Amendments to the claims, filed on May 27, 2008, have been entered in the above-identified application.

### ***REJECTIONS***

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 1-3, 5-16 and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

Art Unit: 1794

claimed invention. In the instant case amended claims 1-3, 5-16 and 18-22 contain(s) the limitation "a rail system." The specification does not disclose a "rail system," it does mention specific "deck rails", "fence rails" etc. However, there is no support for the broader concept of a "system", therefore this limitation is considered new matter.

7. Claims 1-3, 5-16 and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case amended claims 1, 9 and 14 contain(s) the limitation "a rail component." The specification does not disclose a "rail component," it does mention specific "deck rails", "fence rails" etc. However, there is no support for the broader concept of a "rail component", therefore this limitation is considered new matter.

8. Claims 1-3, 5-16 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "rail system" in claims 1-3, 5-16 and 18-22 is unclear and renders the claims vague and indefinite. It is unclear from the specification and the claims what constitutes a rail system beyond the reinforced component.

The term "rail component" in claims 1, 9 and 14 is unclear and renders the claims vague and indefinite. It is unclear from the specification and the claims what constitutes a rail component beyond the reinforced component.

***Claim Rejections - 35 USC § 102***

9. Claims 1-3, 5-16 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakao (U.S. Patent No. 5,443,887).

Regarding Applicant's claims 1, 5, 7, 9, 11, 14, 20 and 22, Nakao discloses a component comprising: a metal substrate having a perforation (*col. 6, line 21*); and a composite outer layer comprising a plastic and at least one filler, wherein the filler is selected from the group consisting of cellulosic fillers and inorganic fillers (*col. 6, lines 26-27 and col. 2, lines 1-5 and lines 40-42*), said composite formed on said substrate such that all sides of said substrate are coated by said outer layer and said composite passes through said perforation in said substrate (*col. 1, lines 12-13, col. 6 lines 11-20 and the figures*).

The limitation "rail component" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, the article of Nakao is deemed to be a "rail system," because Nakao meets all the structural limitations of the claims.

Regarding Applicant's claims 2, 3, 10, 15 and 16, Nakao discloses the substrate is a sheet (*figures 1 and 2*) and substrate is deemed to have a higher bending strength than a comparable size piece of said composite, since Nakao's component has the same claimed structure and composition.

Regarding Applicant's claims 6, 12 and 19, Nakao discloses said plastic is selected from the group consisting of polyethylene, polypropylene, and polyvinyl chloride (*col. 4, lines 3-29*).

Art Unit: 1794

Regarding Applicant's claims 8, 13 and 21, the limitation "said composite is formed about said substrate by a process selected from the group consisting of extrusion, compression molding, and injection molding" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Nakao discloses claimed structure of claims 1, 9 and 14.

Regarding Applicant's claim 18, Nakao discloses said substrate has a plurality of perforations through which the composite passes (*figures 1 and 2*).

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

10. Applicant's arguments in the response filed May 27, 2008 regarding the previous rejections of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Nakao does not teach or even suggest a rail system comprising a rail component.

Applicant has failed to specifically point out how Nakao fails to teach or even suggest a rail component or a rail system.

Art Unit: 1794

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/  
Primary Examiner, Art Unit 1794  
9/2/2008